

### **REMARKS/ARGUMENTS**

Prior to the entry of this Amendment, claims 8-11, 14-16, and 18-20 were pending in this application. Claims 8 and 15 have been amended. No claims have been added and no claims have been canceled. Thus, claims 8-11, 14-16, and 18-20 remain pending in this application. While claims 8 and 15 have been amended, the amendments involve formal matters only. Because no new matter has been added, the amendments do not necessitate a new search. Thus, the Applicant respectfully requests entry of the amendments to place the application in condition for allowance or in better form for appeal.

#### **35 U.S.C. § 112, First Paragraph, Rejection**

The Office Action has rejected claims 8-11, 14-16, and 18-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Also, claims 9-11, 14, 16, and 18-20, under 35 U.S.C. § 112, first paragraph, have been rejected for being dependent upon a rejected base claim. The Applicant respectfully traverses the rejection for at least the following reasons.

The Applicant submits that the use of “hierarchal information in a canonical form” is clear and concise as it enables any person skilled in the art to which it pertains to carry out the Applicant’s invention. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, because the rejection of claims 8-11, 14-16, and 18-20 is over claim elements that are described clearly and concisely.

#### **“A canonical form of an identifier”:**

The Office Action has rejected claim 8 for referring to “a canonical form of an identifier.” Canonicalization is a term understood by people skilled in the art. According to Wikipedia, Canonicalization specifies:

“[t]he process of converting data that has more than one possible representation into a “standard” canonical representation. This can be done to compare different representations for equivalence, to count

the number of distinct data structures (e.g., in combinatorics), to improve the efficiency of various algorithms by eliminating repeated calculations, or to make it possible to impose a meaningful sorting order." (See Wikipedia cited in IDS filed herewith)

More specifically, Lotus Domino Designer Help defines that "a canonical hierarchical name is a series of components separated by slashes." Any person skilled in the art can also find the following easily under "Examples: @Name" from Lotus Domino Designer Help:

*"3. This example returns CN=MaryTsen/OU=Illustration/OU=Documentation/OU=Development/OU=R&D/O=Acme/C=US if that is the current user ID. The hierarchy of the current user ID is appended to the name; no lookup occurs in the Domino Directory.*

*@Name([CANONICALIZE];"Mary Tsen/")* (See Lotus Domino Designer Help cited in IDS filed herewith)

Depending on the version of Lotus Domino Designer software, the "@Name" formula may or may not return a component name (e.g. "CN", "OU", "O", etc.). In order to make the patent specification clear and concise, the patent specification describes "\* /ACME/ INTERACT/US," without any component name, as an example of "a canonical form of an identifier," rather than describing the long example above from Lotus Domino Designer Help.

#### **"Hierarchal information in a canonical form":**

For at least the above reasons, the Applicant submits that it is understood by any person skilled in the art to which it pertains that "@Name([CANONICALIZE]; . . . )" returns "a canonical form of an identifier." Nevertheless, for the sake of expediency and to place the application in condition for allowance or in better form for appeal, the Applicant has amended claims 8 and 15 to use the words "hierarchal information in a canonical form" as it appears to potentially be more favorable to the examiner over "a canonical form of an identifier."

Because the amendment only corrects formal matters and no new matter has been added, the amendment does not necessitate a new search. Thus, the Applicant respectfully

requests entry of the amendment to place the application in condition for allowance or in better form for appeal.

**New view, deny access, and “hidden field”:**

How to make a view can also be understood by any person skilled in the art to which it pertains. According to Lotus Domino Designer Help, any person can create a view by clicking “New view” in Lotus Designer:

1. Open a database in Designer.
  2. Click Views in the Design pane.
  3. Click the New View button above the Work pane. The Create View dialog box appears.
  4. Enter a name for the view in the View name field.
- . . .” (See Lotus Domino Designer Help cited in IDS filed herewith)

Likewise, any person skilled in the art can easily deny access to a view under the view’s properties. Additionally, the patent specification describes clearly and concisely that a “hidden field” is “an additional field which is computed, and hidden except when open for editing.” (Para. 29)

For at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, of claims 8, 15, and their dependent claims 9-11, 14, 16, and 18-20.

**35 U.S.C. § 112, Second Paragraph, Rejection**

The Office Action has rejected claims 8-11, 14-16, and 18-20 under 35 U.S.C. § 112, second paragraph, as failing to comply with the written description requirement. Also, claims 9-11, 14, 16, and 18-20, under 35 U.S.C. § 112, second paragraph, have been rejected for being dependent upon a rejected base claim.

Claim 1 has been rejected. However, the claim has previously been canceled.

Claim 8 has been amended to correct formal matters only, such as removing the leading “the” in front of “identified address entries.” Claim 8 now recites “searching the shared directory *to identify* address entries . . .; and presenting . . . *identified* address entries.” Because

no new matter has been added, the amendment does not necessitate a new search. Thus, the Applicant respectfully requests entry of the amendment to place the application in condition for allowance or in better form for appeal.

Claim 15 has also been amended to correct formal matters only. The Office Action has suggested that claim 15 has been rejected for “including language similar to” claim 8. Claim 15 now distinctly claims a system comprising “a shared directory . . . including hierarchal information in a canonical form . . . ; and . . . provide access to only address entries . . . for which the hierarchal information matches . . . .” Because no new matter has been added, the amendment does not necessitate a new search. Thus, the Applicant respectfully requests entry of the amendment to place the application in condition for allowance or in better form for appeal.

For at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph, of claims 8, 15, and their dependent claims 9-11, 14, 16, and 18-20.

### **35 U.S.C. 103 Rejection, Raghunathan in view of Melchione and Olds**

The Office Action has rejected claims 8-10, 14, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U. S. Publication No. US 2002/0120716 to Raghunathan et al. (hereinafter “Raghunathan”) in view of U. S. Patent No. 5,930,764 to Melchione et al. (hereinafter “Melchione”) and further in view of U. S. Patent No. 5,878,415 to Dale R. Olds (hereinafter “Olds”). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, the references cited by the Office Action do not teach or

suggest each claimed limitation. For example, none of the references, alone or in combination, teaches or suggests searching a directory based on “hierarchal information in a canonical form” or generating an additional view of address entries in a directory wherein the additional view provides access to only those address entries that match the “hierarchal information in a canonical form.”

Raghunathan relates to “a server framework that handles client requests to a database server by equitably distributing resources to the client requests.” (Para. 2) Under Raghunathan, one or more client requests are made to a server for data, the requests are separated into smaller units, and each smaller unit is then serviced in the order it is received. (Para 23) However, as the Office Action has acknowledged, Raghunathan does not teach or suggest denying access based on “hierarchal information in a canonical form” or an address entry in a shared directory.

Melchione is directed to “an electronic sales and service support system and method for assisting customer service and identifying sales targets, distributing sales leads, enhancing sales tools, and tracking performance of sales and sales personnel.” (Col. 1, lines 27-31) More specifically, Melchione “provid[es] a system and method for assembling a comprehensive database from diverse sources and retrieving information from the central database.” (Col. 6, lines 17-20)

However, Melchione fails to teach or suggest denying access based on “hierarchal” information such as the combination of company name and division name involving “successive levels or layers.” (See WordReference.com) Rather, Melchione relies on a “security database [that] stores a list of entitlements, as well as user IDs and passwords for each user of the system.” (Col. 16, lines 65-66) IDs and passwords are not hierarchal as with company name and division name.

Additionally, Melchione’s use of entitlements and IDs, as distinct for each user, does not teach or suggest the use of “hierarchal information in a canonical form,” which is the same for each user within the same hierarchy. Thus, Melchione does not teach or suggest the particular use of “hierarchal information in a canonical form” to deny access.

Olds “particularly . . . relates to inheritance and subtree filtering.” (Col. 1, lines 9-10) However, Olds does not teach or suggest the particular use of “hierarchal information in a canonical form” within a shared directory to search and present address entries. Rather, the two features in Olds merely relate to features of a shared database.

The combination of references is no more relevant to the pending claims than any references alone since none of the references, alone or in combination, teaches or suggests the claimed method of using “hierarchal information in a canonical form” in a shared directory to deny access and to search and present address entries. Rather, Raghunathan relates to equitably distributing resources to client requests. Melchione teaches the use of IDs and passwords. Olds teaches shared database.

Claim 8, upon which claims 9-11 and 14 depend, recites in part “searching the shared directory to identify, by matching the hierarchal information, address entries in the shared directory which includes a plurality of address entries, each of the address entries including hierarchal information in a canonical form in a hidden field.” None of the references, alone or in combination, teaches or suggests the claimed method of using “hierarchal information in a canonical form” in a shared directory to deny access and to search and present address entries. For at least these reasons, claims 8-11 and 14 should be allowed.

Claim 15, upon which claims 16 and 18-20 depend, recites in part “a shared directory in communication with the server which includes a plurality of address entries, each of the address entries including hierarchal information in a canonical form in a hidden field, the hierarchal information being associated with at least one entity of the plurality of entities having access to the shared directory.” None of the references, alone or in combination, teaches or suggests the claimed method of using “hierarchal information in a canonical form” in a shared directory to deny access and to search and present address entries. For at least these reasons, claims 15-16 and 18-20 should be allowed.

**35 U.S.C. 103 Rejection, Olds in view of Singhani**

The Office Action has rejected claims 11 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Olds in view of U. S. Publication No. US 2002/0104018 to Singhani et al. (hereinafter “Singhani”). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

The Office Action has suggested that Singhani teaches the use of supposed “hierarchal information.” However, even a concise example of “hierarchal information in a canonical form” such as “\*/ACME/INTERACT/US” includes division name and geographic location in addition to company name. Rather, the only “hierarchical information” that Singhani suggests is the company name. (Para. 57)

The Applicant’s use of “hierarchal information” clearly includes elements above and beyond merely company name. The additional elements distinctly make the information “hierarchal” as having “successive levels or layers.” (See WordReference.com) Furthermore, under the pending claims, successive levels or layers of hierarchal elements are included “in a canonical form” (i.e. “hierarchal information in a canonical form”) in a shared directory used to deny access and to search and present address entries.

Singhani also teaches that a user request will be “forwarded to the application administrator.” (Para. 57) However, instead of generating “hierarchal information in a canonical form” automatically within the application itself using a formula such as “@Name” with the “[CANONICALIZE]” parameter, Singhani suggests that the creation of any supposed “hierarchical information” is performed by the application administrator.

Moreover, Singhani teaches that the application administrator extracts out the only supposed “hierarchical information,” namely the company name, from the rest of information including “userid (obtained from the Registration home page), the e-mail address, . . . the access level, the name of the application the user requires access to, etc.” (Para. 57) However, the “[CANONICALIZE]” parameter “add[s] in whatever components are missing” in order to produce “hierarchal information in a canonical form.” (Lotus Domino Designer Help,

@Name formula) Thus, Singhani does not teach or suggest the particular use of “hierarchical information in a canonical form” to deny access and to search and present address entries.

Claim 8, upon which claim 11 depends, is thought to be allowable for at least the reasons stated above. That is, the references fail to teach or suggest, alone or in combination, each claimed element. Therefore, claim 11 is thought to be allowable at least for the reason that it depends upon an allowable base claims. Similarly, claim 15, upon which claim 20 depends, is thought to be allowable for at least the reasons stated below. That is, the references fail to teach or suggest, alone or in combination, each claimed element. Therefore, claim 15 is thought to be allowable at least for the reason that it depends upon an allowable base claims. Therefore, the Applicant respectfully requests that the reject of claims 11 and 20 be withdrawn.

**35 U.S.C. 103 Rejection, Raghunathan, Melchione, Olds in view of Freedman**

The Office Action has rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Raghunathan, Melchione, Olds, and further in view of U. S. Publication No. US 2002/0083123 to Freedman et al. (hereinafter “Freedman”). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

Analysis of Raghunathan, Melchione, and Olds for claim 15 is similar to claim 8. Freedman discloses using an indicia for supplying information to consumers because “many consumers are unfamiliar with the complexities of performing network searches and, more significantly, are accustomed to acquiring product information through traditional print and broadcast media.” (Para. 1) However, as is commonly known, a user of Lotus Notes is an organizational person who knows the name of other people in the organizational and can enter the name of other people easily in order to look up an e-mail address. Furthermore, one embodiment of Freedman appears to be the “:CueCat,” which uses a barcode as an indicia for supplying information. However, the use of barcode in the field of consumer advertisement and



the use of “hierarchal information in a canonical form” in the field of organizational information technology are completely different from each other.

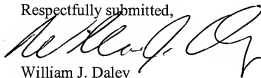
As noted previously, claim 15, upon which claims 16 and 18-20 depend, recites in part “a shared directory in communication with the server which includes a plurality of address entries, each of the address entries including hierarchal information in a canonical form in a hidden field, the hierarchal information being associated with at least one entity of the plurality of entities having access to the shared directory.” None of the references, alone or in combination, teaches or suggests the claimed method of using “hierarchal information in a canonical form” in a shared directory to deny access and to search and present address entries. For at least these reasons, claims 15-16 and 18-20 should be allowed.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



William J. Daley  
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 303-571-4000

WJD:sbm

60776156 v1